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2004

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,302	12/19/2001	Vladimir V. Martin	2086	8077
23358	7590	04/19/2004	EXAMINER	
KOREN ANDERSON MOLECULAR PROBES, INC. 29851 WILLOW CREEK ROAD EUGENE, OR 97402-9132			KIFLE, BRUCK	
		ART UNIT	PAPER NUMBER	
		1624		

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/026,302	MARTIN ET AL.	
	Examiner	Art Unit	
	Bruck Kifle, Ph.D.	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 February 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3,5-10,12,14-21,25-32 and 34-55 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1,3,5-10,12,14-21,25-32 and 34-55 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/14/03.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Applicant's amendments and remarks filed 02/19/04 have been received and reviewed.

Claims 1, 3, 5-10, 12, 14-21, 25-32 and 34-55 are now pending in this application.

After further review of the claims and Applicants remarks, it was deemed that a restriction requirement is necessary because the search and examination of the entire scope of the claims places an undue burden on the office. Each "core" and each "S_C" group supports a different patent.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 5-10, 12, 15-21, 31, 32, 36-40, 42, 43 and 52-54, drawn to compounds and compositions of the compound of claim 1 wherein E¹, E² and E³ are ethylene groups and Y, P and Q are -O-, classified in class 540, subclasses 451, 452, 454, 455 and 469.
- II. Claims 1, 3, 5-10, 12, 14-21, 25-32 and 34-55, drawn to compounds, compositions, methods of use and a kit which subject matter is not embraced by group I above. Should Applicants elect this group, further election of a specific "core" and "S_C" is required. Classifications of all of the compounds, the protein, polysaccharide, biotin, polymer, nucleoside, drug, cell, virus, etc. and method of detecting a target, and the kit is too burdensome.

The inventions are distinct, each from the other because of the following reasons: The claims are not drawn to art recognized equivalents. Groups I and II are drawn to structurally dissimilar compounds. They are made and used independently. They are independent and patentably distinct.

If, say compounds of Group I, were anticipated, applicants would not acquiesce in the rejection of Group II thereover or vice-versa. They are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the search required for Group I is not required for Groups II, restriction for examination purposes as indicated is proper.

A telephone call was made to Ms. Koren Anderson on April 15, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Note that compounds, corresponding compositions, a method of use and a process of making that are of the same scope are considered to form a single inventive concept. The instant claims are not so linked as to form a single inventive concept. The compounds are so diverse in scope that a prior art anticipating one compound under 35 USC 102 would not render obvious another compound of the same claim under 35 USC 103.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 571-272-0668. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Bruck Kifle, Ph.D.
Primary Examiner
Art Unit 1624

BK
April 15, 2004